THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Roger Patrick
and Phillip L. Jones

Appeal No. 2002-1480
Application No. 08/925,985

ON BRIEF

Before KRATZ, JEFFREY SMITH, and Pawlikowski, Administrative Patent Judges. KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of this appeal leads us to conclude that this case is not in condition for a decision at this time. Accordingly, we remand this application to the examiner to consider the following issues and to take appropriate action. This appeal is from the examiner's final rejection of claims 1, 2, 4-10 and 25-33, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method of etching a substrate in a plasma processing chamber using a sacrificial substrate holder for allegedly obtaining improved etch uniformity.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Zhao et al. (Zhao)	5,558,717	Sep. 24, 1996
Hills et al. (Hills)	5,685,914	Nov. 11, 1997 (Filed Apr. 05, 1994)
Abraham	5,772,906	Jun. 30, 1998 (Filed May 30, 1996)
Ye et al. (Ye)	5,891,348	Apr. 06, 1999 (Filed Jan 26, 1996)
Abraham et al. (Abraham)	5,952,244	Sep. 14, 1999 (Filed Feb. 15, 1996)
Rossman et al. (Rossman)	6,077,357	Jun. 20, 2000 (Filed May 29, 1997)
Bhan et al. (Bhan)	6,090,167	Jul. 18, 2000 (Filed Oct. 06, 1999)[1]
Shamouilian et al. (Shamouilian)	6,095,084	Aug. 01, 2000 (Filed Jul. 14, 1997)
Kao et al. (Kao)	6,125,859	Oct. 03, 2000 (Filed Jul. 11, 1997)

Claims 1, 2, 4-10 and 25-33 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention. Claims 1, 2, 4-10, 25, 29-

[1] Division of application No. 08/616,707 filed on March 15, 1996 and now U.S. Patent No. 6,001,728.

31 and 33 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Ye. Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ye. Claims 1, 2, 7, 25, 31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hills in view of Shamouilian, Kao, Zhao, Bhan, Rossman and Ye. Claims 4-6, 8-10, 26-30 and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hills in view of Shamouilian, Kao, Zhao, Bhan, Rossman, Ye, Abraham and Abraham et al.

Discussion

The position of the examiner as to the inclusion of claims 26-28 in the § 112, second paragraph rejection set forth at page 4 of the answer is contrary to the position espoused at page 2 of the answer wherein the examiner indicates that the rejection of claims 26-28 under § 112, second paragraph is withdrawn.

We remand this application to the jurisdiction of the examiner for resolution of this inconsistency and to take other appropriate action, as may be considered appropriate. The submission of a corrected answer is authorized to the extent such is an appropriate course of action under current office practices and procedures. That would afford appellants an opportunity to submit a reply brief further addressing the § 112, second

paragraph rejection of claims 26-28 should the examiner maintain that rejection.

Concerning this matter, we note that appellants do not explain in the brief how the language of any of claims 26-28 renders those claims definite for an additional reason over the arguments made for independent claim 25 or independent claim 1. In this regard, we note that merely pointing out what the claim language of claim 26 is does not meet the requirements of 37 CFR § 1.192 (c)(8)(ii) as a separate argument for specifying how the language of claims 26-28 renders those claims definite. We recognize that the language "consisting essentially of" limits the scope of a compositional component of a claim to the specified ingredients and those that do not materially affect the basic and novel characteristics of the component. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). However, neither the appellants' brief or the examiner's answer addresses what those characteristics are for the upper planar surface of the substrate holder of claims 26-28 and how those characteristics may make claims 26-28 separately patentable based thereon as opposed to the other appealed claims that do not include such restrictive terminology.

As a consequence, the issues have not been fully developed and joined by appellants and the examiner for our review in making a decision on the rejections advanced by the examiner in the answer.

Under the circumstances recounted above, the record before us is not in a condition which permits a proper disposition of the subject appeal. We are constrained, therefore, to remand this application to allow for the clarification of the file record by both the examiner and appellants with respect to the rejection previously advanced by the examiner and for the examiner to reconsider the claimed subject matter and the rejections of record in light of the above discussion.

This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure § 708.01 (8th ed., August 2001). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

PETER F. KRATZ
Administrative Patent Judge)
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Jeffrey Smith) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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Beverly A. Pawlikowski)
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PFK/dpv

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